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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,549	09/04/2003	David W. Roth	B2745.0028/P0028	1609
7590 BEH Investments 1652 48th Street Brooklyn, NY 11204				
EXAMINER				
MYHRE, JAMES W				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
04/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/655,549

**Applicant(s)**

ROTH ET AL.

**Examiner**

JAMES W. MYHRE

**Art Unit**

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 99-166 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 99-166 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date : 1/04; 5/05; 9/05; 11/07; and 12/07.

## **DETAILED ACTION**

### ***Reissue Applications***

1. This Office Action is in response to the fourth preliminary amendment filed on January 5, 2007. The preliminary amendment cancelled previously submitted Claims 18-98 and added new Claim 99-166. Therefore, the currently pending claims considered below are Claims 1-17 and 99-166.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

"all oaths/declaration in a broadening reissue application must be signed by all of the inventors (except as otherwise provided in the rules – see 37 CFR §§ 1.42, 1.43, 1.47) In a non-broadening reissue application, either all the inventors or all the assignees must sign the oath or declaration" (MPEP 1410.01).

The instant reissue application contains broadening claims, and, thus, requires the signatures of all of the inventors.

3. Claims 99-166 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Declaration is set forth in the discussion above in this Office action.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4, 15, and 99-166 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al (US 2001/0042064 A1).

Claims 1 and 4: David discloses a system for supplying advertisements, comprising:

- a. a web server storing a plurality of advertisements (page 4, paragraph 0041 and page 5, paragraph 0045);
- b. a plurality of bidding agents (page 4, paragraph 0041 and page 5, paragraph 0048);
- c. a server for providing information concerning each view-op to the bidding agents (page 5, paragraphs 0045 and 0048);
- d. a bid input system for providing bids including a reference to a specific advertisement, specifications (parameters) for a desired view-op, and a monetary amount to be paid for displaying the specific advertisement (page 5, paragraph 0048 and page 7, paragraphs 0060 and 0063); and

e. the server selecting the highest bid and transferring the advertisement to the web site (content requestor) (page 5, paragraph 0049 and page 7, paragraph 0063).

The Examiner considers placement of the advertisement ("a short textual description...of the content of the advertiser's web site" that "may also contain a title of the web site")(page 7, paragraph 0062) on the search results listing as an opportunity to present their advertisement to the searcher; thus, equivalent to a view-op.

Claim 15: Davis discloses a system as in Claim 1 above, and further discloses the server includes information (database) about web sites (page 3, paragraph 0028 and page 7, paragraph 0060).

Claims 99 and 133: Davis discloses a system and method for supplying advertisements, comprising:

- a. maintaining (storing) a plurality of bidding parameters associated with an advertisement specifying at least web page characteristics (e.g. search terms)(page 5, paragraph 0048 and page 7, paragraph 0060);
- b. receiving a request for content from a client including an advertising opportunity (page 5, paragraphs 0046 and 0050; page 9, paragraph 0083; and page 10, paragraphs 0084-0085);
- c. submitting bids based on matching the bidding parameters with the advertising opportunity (page 3, paragraphs 0025 and 0027; page 5, paragraphs 0048-0051; and page 7, paragraphs 0060-0061);

d. including a monetary amount the advertiser is willing to pay if the advertisement is selected to display to the client (page 7, paragraph 0060); and

e. selecting a bid and the corresponding advertisement by a bidding process (page 3, paragraph 0026; page 5, paragraph 0049; page 7, paragraph 0063; and page 10, paragraph 0085).

**Examiner's Note:** The following limitations are added by numerous dependent claims with crossing dependencies. In order to eliminate redundant rejections of the same limitations, the claims including the same additional limitation have been grouped together.

Claims 100, 113, 123, 134, 147, and 157: Davis discloses a system and method as in Claims 99 and 133 above, and further discloses the monetary amount is included in the bid (page 7, paragraph 0063).

Claims 101, 114, 124, 135, 148, and 158: Davis discloses a system and method as in Claims 99 and 133 above, and further discloses the specific event is the same for all submitted bids (Davis discloses the event is the selection of the advertisement by the client)(page 7, paragraph 0063).

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Claims 102, 103, 115, 116, 125, 126, 136, 137, 149, 150, 159, and 160: Davis discloses a system and method as in Claims 99 and 133 above, and further discloses the event is delivering (serving) the advertisement (page 7, paragraph 0063).

Claims 104-108, 117-121, 127-131, 138-142, 151-155, and 161-165: Davis discloses a system and method as in Claims 99 and 133 above, and further discloses the request for content by the browser is caused by a reference (link) in a web page (page 6, paragraph 0051 and page 7, paragraphs 0062-0063).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 3, 5-14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (US 2001/0042064 A1) in view of Goldhaber et al (5,794,210).

Claims 2, 3, 5-7, 9, 12-14, and 17: David discloses a system and method for supplying advertisements, comprising:

a. a web server storing a plurality of advertisements (page 4, paragraph 0041 and page 5, paragraph 0045);



b. a plurality of bidding agents (page 4, paragraph 0041 and page 5, paragraph 0048);

c. a server for providing information concerning each view-op to the bidding agents (page 5, paragraphs 0045 and 0048);

d. a bid input system for providing bids including a reference to a specific advertisement, specifications (parameters) for a desired view-op, and a monetary amount to be paid for displaying the specific advertisement (page 5, paragraph 0048 and page 7, paragraphs 0060 and 0063); and

e. the server selecting the highest bid and transferring the advertisement to the web site (content requestor) (page 5, paragraph 0049 and page 7, paragraph 0063).

However, Davis does not explicitly disclose storing a viewer database with demographic and/or historic information pertaining to the viewer (content requestor) that is used by the advertiser to determine the bid amount. However, Goldhaber discloses a similar system and method for supplying advertisements in which the advertisers use attention bidding to bid for the viewer's attention. These bids might be based, in part, on estimates of the viewer's interest and likelihood to buy – estimates derived from access to the viewer's electronic profiles detailing preferences and past consuming behavior". Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the advertisers in Davis to base their bids not only on the search terms entered by the viewer, but also on other demographic or historic data pertaining to the viewer. One would have been motivated to use viewer

information in this manner in order to increase "the viewer's interest and likelihood to buy" as discussed in Goldhaber.

Claim 8: Davis and Goldhaber disclose a system as in Claim 7 above, and Davis further discloses the world wide web is accessed using HTTP protocol (as is usual in the art)(page 4, paragraphs 0043-0044).

Claim 10: Davis and Goldhaber disclose a system as in Claim 9 above, and Davis further discloses checking the bids to determine if the web page meets (matches) the specification of the bid (page 5, paragraph 0048).

Claim 11: Davis and Goldhaber disclose a system as in Claim 9 above, and Davis further discloses determining and placing bids in real time (page 3, paragraph 0027; page 7, paragraph 0068; page 10, paragraphs 0088-0089; and page 11, paragraph 0091). Davis discloses the process is "an ongoing online competitive bidding process with other web site promoters" and that the advertiser can change the bid whenever notified that other bid has bumped his bid from its previous placement. This implies, or at least renders it obvious, that the bidding is online and in real time in order to submit the replacement bid before the advertiser's advertisement is bumped, i.e. such as in a normal auction-like environment.

Claim 16: Davis discloses a method for supplying and pricing advertisements, comprising:

- a. receiving electronic bids from advertisers for specific advertisements to be presented to clients with matching search terms (page 3, paragraphs 0025 and 0027; and page 5, paragraphs 0048-0051);
- b. selecting the highest bid among the electronic bids (page 3, paragraph 0026; page 5, paragraph 0049; page 7, paragraph 0063; and page 10, paragraph 0085);
- c. transmitting the selected advertisement to the matching clients (page 7, paragraph 0063);
- d. calculating the delivery fee (bid cost) for the advertisement (page 5, paragraph 0049 and page 7, paragraph 0063); and
- e. generating and transmitting an advertising bill to the advertiser (page 3, paragraph 0027).

However, Davis does not disclose storing client profile information in a database and using the profile information to determine the bid amount. However, Goldhaber discloses a similar system and method for supplying advertisements in which the advertisers use attention bidding to bid for the viewer's attention. These bids might be based, in part, on estimates of the viewer's interest and likelihood to buy – estimates derived from access to the viewer's electronic profiles detailing preferences and past consuming behavior". Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the advertisers in Davis to base their bids not only on the search terms entered by the viewer, but also on other

demographic or historic data pertaining to the viewer. One would have been motivated to use viewer information in this manner in order to increase "the viewer's interest and likelihood to buy" as discussed in Goldhaber.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM

April 16, 2008

/James W Myhre/

Primary Examiner, Art Unit 3688